

APPENDIX.

Statutes.

Patent Act of 1836 (Act of July 4, 1836, ch. 357, 5 Stat. 117):

“Section 7. *And be it further enacted*, That on the filing of any such application, description, and specification, and the payment of the duty hereinafter provided, the Commissioner shall make, or cause to be made, an examination of the alleged new invention or discovery; and if, on any such examination, it shall not appear to the Commissioner that the same had been invented or discovered by any other person in this country prior to the alleged invention or discovery thereof by the applicant, or that it had been patented, or described in any printed publication in this or any foreign country, or had been in public use or on sale with the applicant's consent or allowance prior to the application, if the Commissioner shall deem it to be sufficiently useful and important, it shall be his duty to issue a patent therefor * * * if the specification and claim shall not have been so modified as, in the opinion of the Commissioner, shall entitle the applicant to a patent, he may, on appeal, and upon request in writing, have the decision of a board of examiners, to be composed of three disinterested persons, who shall be appointed for that purpose by the Secretary of State, * * * it shall be in their power, or of a majority of them, to reverse the decision of the Commissioner, either in whole or in part, and their opinion being certified to the Commissioner, he shall be governed thereby in the further proceedings to be had on such application. * * *

“Section 8. *And be it further enacted*, That whenever an application shall be made for a patent which, in the opinion of the Commissioner, would interfere with any other patent for which an application may be pending, or with any unexpired patent which shall have been granted, it shall be the duty of the Commissioner to give notice thereof to such applicants, or patentees, as the case may be; and if either shall be dissatisfied with the decision of the Commissioner on the question of priority of right or invention, on a hearing thereof,

he may appeal from such decision, on the like terms and conditions as are provided in the preceding section of this act; and the like proceedings shall be had, to determine which or whether either of the applicants is entitled to receive a patent as prayed for. . . .”

“Section 16. *And be it further enacted*, That whenever there shall be two interfering patents, or whenever a patent on application shall have been refused on an adverse decision of a board of examiners, on the ground that the patent applied for would interfere with an unexpired patent previously granted, any person interested in any such patent, either by assignment or otherwise, in the one case, and any such applicant in the other case, may have remedy by bill in equity; and the Court having cognizance thereof, on notice to adverse parties, and other due proceedings had, may adjudge and declare either the patents void in the whole or in part, or inoperative or invalid in any particular part or portion of the United States, according to the interest which the parties to such suit may possess in the patent or the inventions patented, and may also adjudge that such applicant is entitled, according to the principles and provisions of this act, to have and receive a patent for his invention, as specified in his claim, or for any part thereof, as the fact of priority of right or invention shall in any such case be made to appear. And such adjudication, if it be in favor of the right of such applicant, shall authorize the Commissioner to issue such patent, on his filing a copy of the adjudication, and otherwise complying with the requisitions of this act. *Provided however*, That no such judgment or adjudication shall affect the rights of any person except the parties to the action and those deriving title from or under them subsequent to the rendition of such judgment.”

Patent Act of 1839 (Act of March 3, 1839, ch. 88, 5 Stat. 353):

“Section 10. *And be it further enacted*, That the provisions of the sixteenth section of the before-recited act shall extend to all cases where patents are refused for any reason whatever, either by the Commissioner

of Patents or by the Chief Justice of the District of Columbia, upon appeals from the decision of said Commissioner, as well as where the same shall have been refused on account of, or by reason of, interference with a previously existing patent; and in all cases where there is no opposing party, a copy of the bill shall be served upon the Commissioner of Patents, when the whole of the expenses of the proceeding shall be paid by applicant, whether the final decision shall be in his favor or otherwise."

"Section 11. *And be it further enacted*, That in all cases where an appeal is now allowed by law from the decision of the Commissioner of Patents to a board of examiners, provided for in the seventh section of the act to which this is additional, the party, instead thereof, shall have a right to appeal to the Chief Justice of the district court of the United States for the District of Columbia, by giving notice thereof to the Commissioner, and filing in the Patent Office, within such time as the Commissioner shall appoint, his reasons of appeal specifically set forth in writing, and also paying into the Patent Office, to the credit of the patent fund, the sum of twenty-five dollars. And it shall be the duty of said Chief Justice, on petition, to hear and determine all such appeals, and to revise such decisions in a summary way, on the evidence produced before the Commissioner, at such early and convenient time as he may appoint. . . ."

Consolidated Patent Act of 1870 (Act of July 8, 1870, ch. 230, 16 Stat. 198):

"Section 52. *And be it further enacted*, That whenever a patent on application is refused, for any reason whatever, either by the commisisoner or by the Supreme Court of the District of Columbia upon appeal from the commissioner, the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And

such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent, on the applicant filing in the Patent Office a copy of the adjudication, and otherwise complying with the requisitions of law. And in all cases where there is no opposing party a copy of the bill shall be served on the commissioner, and all the expenses of the proceeding shall be paid by the applicant, whether the final decision is in his favor or not."

"Section 58. *And be it further enacted*, That whenever there shall be interfering patents, any person interested in any one of such interfering patents, or in the working of the invention claimed under either of such patents, may have relief against the interfering patentee, and all parties interested under him, by suit in equity against the owners of the interfering patent; and the court having cognizance thereof, as hereinbefore provided, on notice to adverse parties, and other due proceedings had according to the course of equity, may adjudge and declare either of the patents void in whole or in part, or inoperative, or invalid in any particular part of the United States, according to the interest of the parties in the patent or the invention patented. But no such judgment or adjudication shall affect the rights of any person except the parties to the suit and those deriving title under them subsequent to the rendition of such judgment."

.

Section 481. R. S. (U. S. C. title 35, section 6). The Commissioner of Patents, under the direction of the Secretary of Commerce, shall superintend or perform all duties respecting the granting and issuing of patents directed by law; and he shall have charge of all books, records, papers, models, machines, and other things belonging to the Patent Office.

Section 4886. R. S. (U. S. C., title 35, section 31). Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, or who has invented or discovered and asexually reproduced any dis-

inct and new variety of plant, other than a tuber-propagated plant, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof or more than one year prior to his application, and not in public use or on sale in this country for more than one year prior to his application, unless the same is proved to have been abandoned, may, upon proceeding had, obtain a patent therefor (The period is *two years* instead of "one year" where the application was filed prior to August 5, 1940. See Section 2 of Act of August 5, 1939, *infra*.)

Act of August 5, 1939, 53 Stat. 1212:

Section 2. This Act (amending sections 4886, 4887, 4920, and 4929 of the Revised Statutes—U. S. C., title 35, sections 31, 62, 69, and 73—by changing "two years" to *one year*) shall take effect one year after its approval and shall apply to all applications for patent filed after it takes effect and to all patents granted on such applications: *Provided, however*, That all applications for patents filed prior to the time this Act takes effect and all patents granted on such applications are to be governed by the statutes in force at the time of approval of this Act as if such statutes had not been amended.

Section 4904. R. S. (U. S. C., title 35; section 52). Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct a board of three examiners of interferences to proceed to determine the question of priority of invention. And the Commissioner may issue a patent to the party who is adjudged the prior inventor. (As to the interferences declared prior to October 5, 1939, see Section 5 of Act of August 5, 1939, *infra*.)

Act of August 5, 1939, 53 Stat. 1212:

Section 5. This Act (amending sections 4904, 4909, 4911, and 4915 of the Revised Statutes—U. S. C., title 35, sections 52, 57, 59a, and 63—) shall take effect two months after its approval; but it shall not affect interferences then pending, which may be heard and decided and appeals and other proceedings taken under the statutes in force at the time of approval of this Act as if such statutes had not been amended.

Section 4911. R. S. (U. S. C., title 35, section 59a). If any applicant is dissatisfied with the decision of the Board of Appeals, he may appeal to the United States Court of Customs and Patent Appeals, in which case he waives his right to proceed under section 4915 of the Revised Statutes (U. S. C., title 35, section 63). If any party to an interference is dissatisfied with the decision of the board of interference examiners he may appeal to the United States Court of Customs and Patent Appeals, provided that such appeal shall be dismissed if any adverse party to such interference shall within twenty days after the appellant shall have filed notice of appeal according to section 4912 of the Revised Statutes (U. S. C., title 35, section 60), file notice with the Commissioner of Patents that he elects to have all further proceedings conducted as provided in section 4915 of the Revised Statutes. Thereupon the appellant shall have thirty days thereafter within which to file a bill in equity under said section 4915, in default of which the decisions appealed from shall govern the further proceedings in the case. (As to interference declared prior to October 5, 1939, see section 5 of Act of August 5, 1939, printed after R. S. section 4904, *ante*.)

Section 4915. R. S. (U. S. C., title 35, section 63). Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may

be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit. (As to interferences declared prior to October 5, 1939 see Section 5 of Act of August 5, 1939, printed after R. S. Section 4904, *ante*.)

Act of March 3, 1927, 44 Stat. 1394 (U. S. C., title 35, 72a):

And upon the filing of a bill in the District Court of the United States for the District of Columbia wherein remedy is sought under section 4915 or section 4918 of the Revised Statutes (U. S. C., title 35, sec. 63 or sec. 66), without seeking other remedy, if it shall appear that there is an adverse party residing in a foreign country, or adverse parties residing in a plurality of districts not embraced within the

same State, the court shall have jurisdiction thereof and writs shall, unless the adverse party or parties voluntarily make appearance, be issued against all of the adverse parties with the force and effect and in the manner set forth in this section (section 113 of title 28 U. S. C.): *Provided*, That writs issued against parties residing in foreign countries pursuant to this section may be served by publication or otherwise as the court shall direct.

Section 4918. R. S. (U. S. C., title 35, section 66). Whenever there are interfering patents, any person interested in any of them, or in the working of the invention claimed under either of them, may have relief against the interfering patentee, and all parties interested under him, by suit in equity against the owners of the interfering patent; and the court, on notice to adverse parties, and other due proceedings had according to the course of equity, may adjudge and declare either or both the patents void in whole or in part upon any ground, or inoperative, or invalid in any particular part of the United States, according to the interest of the parties in the patent or the invention patented, but no such judgment or adjudication shall affect the right of any person except the parties to the suit and those deriving title under them subsequent to the rendition of such judgment.

RULES OF PRACTICE IN THE UNITED STATES PATENT OFFICE.

Rule 63 (d). Applications which appear to interfere with other applications previously considered and found to be allowable, or which it is demanded shall be placed in interference with an unexpired patent or patents.

Where an applicant copies claims from a patent and the examiner is of the opinion that he can make none of these claims, he should state in his action why he can not make the claims and set a time limit, not less than twenty days, for reply. If, after response by the applicant, the rejection is made final, a similar time limit should be set

for appeal. Failure to respond or appeal, as the case may be, within the time fixed, will in the absence of a satisfactory showing, be deemed a disclaimer of the invention claimed. (See rule 94.)

Applications will not be advanced for examination excepting upon order of the Commissioner either to expedite the business of the office or upon a verified showing which in the opinion of the Commissioner will justify so advancing it.

Rule 93. An interference is a proceeding instituted for the purpose of determining the question of priority of invention between two or more parties claiming substantially the same patentable invention and may be instituted as soon as it is determined that common patentable subject matter is claimed in a plurality of applications or in an application and a patent. In order to ascertain whether any question of priority arises the Commissioner may call upon any junior applicant to state in writing under oath the date and the character of the earliest fact or act, susceptible of proof, which will be relied upon to establish conception of the invention under consideration. The sworn statement filed in compliance with this rule will be retained by the Patent Office separate from the application file and if an interference is declared will be opened simultaneously with the preliminary statement of the party filing the same. In case the junior applicant makes no reply within the time specified, not less than twenty days, the Commissioner will proceed upon the assumption that the said date is the date of the oath attached to the application. The fact that one of the parties has already obtained a patent will not prevent an interference, for, although the Commissioner has no power to cancel a patent, he may grant another patent for the same invention to a person who proves to be the prior inventor.

Rule 94. Interferences will be declared between applications by different parties for patent or for reissue when such applications contain claims for substantially the same

invention which are allowable in the application of each party, and interferences will also be declared between applications for patent, or for reissue, and unexpired original or reissued patents, of different parties, when such applications and patents, contain claims for substantially the same invention which are allowable in all of the applications involved: *Provided*, That where the filing date of any applicant is subsequent to the filing date of any patentee, the applicant shall file an affidavit that he made the invention in controversy, in this country, before the filing date of the patentee; and, when required, the applicant shall file an affidavit setting forth facts showing that he completed the invention in controversy, in this country, before the filing date of the patentee.

Where claims are copied from a patent and the examiner is of the opinion that the applicant can make only some of the claims so copied, he shall notify the applicant to that effect, state why he is of the opinion he cannot make the other claims and state further that the interference will be promptly declared and that the applicant may proceed under rule 109, if he further desires to contest his right to make the claims not included in the declaration of the interference.

Where an applicant presents a claim copied or substantially copied from a patent, he must, at the time he presents the claim, identify the patent, give the number of the patented claim, and specifically apply the terms of the copied claim to his own disclosure.

No amendment for the first time presenting or asserting a claim which is the same as, or for substantially the same subject matter as, a claim of an issued patent may be made in any application unless such amendment is filed within one year from the date on which said patent was granted.

Parties owning applications or patents which contain conflicting claims will be required to show cause why these claims shall not be eliminated from all but one of the applications or patents of common ownership.

Rule 95. Before the declaration of interference it must be determined that there is common patentable subject matter in the cases of the respective parties. The issue must be clearly defined and be patentable to the respective parties, subject to the determination of the question of priority.

In case the subject matter in controversy has been patented to one of the parties but is deemed by the examiner not to be patentable to an applicant, he shall call the case to the attention of the Commissioner.

Rule 96. Whenever the claims of two or more applications differ in phraseology, but relate to substantially the same patentable subject matter, the examiner shall suggest to the parties such claims as are necessary to cover the common invention in substantially the same language. The examiner shall send copies of the letter suggesting claims to the applicant and to the assignee, as well as to the attorney or agent of record in each case. The parties to whom the claims are suggested will be required to make those claims within a specified time in order that an interference may be declared. Upon the failure of any applicant to make any claim suggested within the time specified, such failure or refusal shall be taken without further action as a disclaimer of the invention covered by that claim unless the time be extended upon a proper showing. After judgment of priority the application of any party may be held for revision and restriction, subject to interference with other applications.

Whenever it shall be found that two or more parties whose interests are in conflict are represented by the same attorney or agent, the examiner shall notify each of said principal parties and also the attorney or agent of this fact.

Rule 149. When an appeal is taken to the United States Court of Customs and Patent Appeals, the appellant shall give notice thereof to the Commissioner, and file in the Pat-

ent Office, within 40 days, exclusive of Sundays and legal holidays in the District of Columbia but including Saturday half holidays, from the date of the decision appealed from, his reasons of appeal specifically set forth in writing; *Provided*, however, That if a petition for rehearing or reconsideration is filed within 20 calendar days after said decision, the notice of appeal may be given and the reasons of appeal filed within 15 calendar days after action on the petition. No petition for rehearing or reconsideration filed more than 20 calendar days after such decision, nor any proceedings on such petition, shall operate to extend the period of 40 days hereinabove provided for appeal.

If any applicant in an *ex parte* case appeals to the U. S. Court of Customs and Patent Appeals he waives his right to proceed under section 4915 R. S. (U. S. C., title 35, section 63).

If a defeated party to an interference proceeding appeals to the U. S. Court of Customs and Patent Appeals, and any adverse party to the interference shall, within twenty days after the appellant shall have filed notice of the appeal to the court, file notice with the Commissioner that he elects to have all further proceedings conducted as provided in section 4915 R. S., certified copies of the foregoing papers will be transmitted to the U. S. Court of Customs and Patent Appeals for such action as may be necessary. The notice of election must be served as provided in rule 154 (b). See rule 153 (a).

From adverse decisions by the board of appeals in *ex parte* cases and from decisions of the board of interference examiners, the appellant, if an applicant, has the option of proceeding under section 4915 R. S. instead of appealing directly to the U. S. Court of Customs and Patent Appeals.